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Total Number of Pages in This Submission: 4

Application Number	09/995,933
Filing Date	11/28/2001
First Named Inventor	Casler
Art Unit	2872
Examiner Name	Lee A. Fineman
Attorney Docket Number	CASL01NP

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/ Incomplete Application
  - ☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
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- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
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- ☐ Appeal Communication to Board of Appeals and Interferences
- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) (please identify below):

Remarks

- Reply Brief (3 pages)
- in response to Examiner's Answer dated 05/17/2005

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name			
Signature	/David S Alavi/		
Printed name	David S Alavi		
Date	07/11/2005	Reg. No.	40310

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Docket No. CASL01NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Christopher L. Casler
Filed: 11/28/2001
App. No.: 09/995,933
For: Hemispheric lens for a remote-controlled retail electronic entertainment device

Art Unit: 2872
Examiner: Lee A. Fineman

REPLY BRIEF UNDER 37 CFR § 41.41

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

07/11/2005

Sir:

In response to the Examiner's Answer dated 05/17/2005, please enter the following Reply Brief.

Applicant respectfully maintains his traversal of the rejection of Claims 1, 2, 4, 9, 10, and 12 under 35 USC §103(a) as being unpatentable over Keitoku (US 5,036,188) in view of Harwood (GB 1,500,495) and Haddock (US 4,912,880) or Takahashi (US 4921,330), for the reasons already set forth in the Appeal Brief, and for the reasons set forth hereinbelow.

It is stated in the Examiner's Answer that Keitoku discloses an audio-visual remote controlled retail electronic device, acknowledges the problem of a limited filed of view, and sets forth the solution of incorporating a hemispherical lens into the original product. Applicant does not dispute this assertion. It is further asserted in the Examiner's Answer that the various deficiencies of Keitoku are remedied by the teachings of Harwood and Haddock or Takahashi, and that it would have been obvious to combine the teachings of these references to arrive at the claimed invention. Applicant does not dispute the assertion that all of the limitations of the Claims may be found in the collective disclosure of the references of Keitoku, Harwood, Haddock, and Takahashi. However, Applicant respectfully traverses the assertion that it would have been obvious to combine the teachings of these references to arrive at the claimed invention.

Applicant respectfully reiterates his principal argument from the Appeal Brief. The very nature of the specific retail electronic entertainment devices recited in the claims and available at the time the invention was made teaches away from any sort of

retro-fitting of the devices, and therefore teaches away from any use of the teachings of the secondary references to modify the device of Keitoku as recited in the appealed claims. As is well known to those skilled in the art, the specific electronic entertainment devices recited in the claims and intended for retail sale have become essentially consumable, disposable products. Devices are manufactured on assembly lines by unskilled labor, and the plastic outer cases (including the front faces) of such devices are usually snap- or press-fit together. The devices are not intended to be reopened, modified, repaired, or retro-fitted in any way, and often cannot be reopened without damaging the device. Applicant therefore respectfully submits that, based on the nature of the retail electronic devices specifically recited in the Claims, a rejection under 35 USC § 103, based on Keitoku in combination with a teaching of retro-fitting supplied by Harwood or by any other reference, is improper.

It should be noted that while the list of retail electronic entertainment devices in the specification is left open-ended, the list of such devices recited in the claims is not. The claims are intended to encompass only those retail electronic entertainment devices explicitly recited therein. It is these devices that are referred to in the preceding paragraph.

In the Grounds of Rejection of the Examiner's Answer, it is stated on page 4, paragraph 2 that "Further it is very well known in the electronic art to purchase add-on devices with instructions from a retail electronic store." This statement is quite true when pertaining to *electronic* add-on devices for the recited retail electronic entertainment devices, however, such electronic add-on devices are connected via electrical connectors already present on the retail electronic device. Applicant is not aware of any add-on devices available for any of the retail electronic devices recited in the claims that are not of an electronic nature; nor have any such examples been provided. Applicant is not aware of any add-on devices available for any of the retail electronic devices recited in the claims that may be added in the absence of some adaptation therefor already present on the retail electronic device (such as an electrical connector, for example); nor have any such examples been provided. Applicant is not aware of any add-on devices available for any of the retail electronic devices recited in the claims that may be added by being stuck on the electronic retail device with adhesive; nor have any such examples been provided. Applicant respectfully submits that the rejection, based on the assertion without one or more such supporting examples, is improper.

Applicant respectfully submits that it is not argued in the Appeal Brief that Keitoku teaches away from retrofitting the device "because Keitoku sets forth a solution incorporating the hemispheric lens in to the original product..." (page 6 of Examiner's Answer). As stated hereinabove, it is argued in the Appeal Brief that it is the nature of the retail electronic devices themselves that teaches away from retrofitting. It is also argued in the Appeal Brief that Keitoku implicitly teaches away from such retrofitting, since every embodiment disclosed by Keitoku would be mechanically unsuitable for the retrofitting recited in the appealed Claims.

In conclusion, Claims 1, 2, 4, 9, 10, and 12 have been rejected over a combination of references. All of the limitations of the rejected claims may be found in the collective disclosure of the combination of references. However, this is not a sufficient basis for rejecting the claims under 35 USC §103 absent some teaching or motivation in the prior art to combine the teachings of the references, and Applicant respectfully submits that such teaching or motivation has not been exhibited.

Many, many patentable inventions comprise combinations of known elements that nevertheless provide a "new and useful result" (the criterion for patentability; *In re Wright*, 122 USPQ 522). The appealed claims each comprise a combination of known elements, and these known elements have indeed been culled from a collection of prior art references. However, the references relied on do not provide teaching or motivation sufficient to lead one of ordinary skill in the art to the "new and useful result" embodied in the appealed claims. Such teaching or motivation is found only in the Applicant's disclosure. If it "appears the appellant is arguing against the references individually" (Examiner's Answer, page 8), it may be due to the lack of adequate teaching or motivation to combine the references.

In view of the above, Applicant respectfully submits that the rejection of Claims 1, 2, 4, 9, 10, and 12 is improper, and respectfully requests that the Board reverse the rejection.

Respectfully submitted,

/David S Alavi/

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